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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,646	06/08/2000	Vernon M. Williams	4210US (99-0173)	1022
7590 Joseph A Walkowski Trask Britt & Rossa P O Box 2550 Salt Lake City, UT 84110		09/12/2007	EXAMINER MITCHELL, JAMES M	
			ART UNIT 2813	PAPER NUMBER
			MAIL DATE 09/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/590,646

Applicant(s)

WILLIAMS ET AL.

Examiner

James M. Mitchell

Art Unit

2813

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 3,9,32,38,50,54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-31,33-37,39-53 and 55-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/11/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's remarks filed April 11, 2007.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on April 11, 2007 was filed after the mailing date of the office action on January 24, 2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1, 2, 4-8, 10-25, 26-31, 33-37, 39-49, 51-53, 55-66 and 67- 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no structural limitation as claimed to inform one of ordinary skill in the art to the metes and bounds of a jacket¹ in the context of male and female sockets. For examination purposes a jacket has simply been interpreted as ring or female member.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

¹ In addition, applicant in his remarks indicated that a jacket is not disclosed citing only that the reference discloses a ring and pedestal. Applicant needs to affirmatively distinguish between the claimed jacket and ring.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1, 2, 4-8, 10-24, 26-31, 33-37, 39-49, 51-53, 55-65 and 67- 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subrahmanyam et al. (U.S. 5,411,400).

7. Subrahmanyam (Fig. 1, 8, 9) disclose:

(cl. 1, 22, 26, 27-30, 35, 36, 47, 48, 64, 65, 67, 68) a conductive structure for connecting a contact pad of a semiconductor device/flip-chip/CSP or semiconductor die with bond pads arranged in an array on a surface thereof and a contact-pad of a substrate/carrier substrate (e.g. carries chip), comprising: a female member/2nd member (42) configured to be secured to the contact pad (23) of one of the semiconductor device (11) and the substrate (13/22), said female member having: a jacket (e.g., understood to mean any outer surface of a member, e.g. 34) with an aperture/receptacle (e.g. terminal, 32 inserted in; not labeled) configured to be located over the contact pad; and a conductive center partially filling² said aperture (e.g. member with a recess/aperture with bottom) that with an upper portion of said aperture being open (Fig. 9); and a male member/1st member (32) configured to be secured to the corresponding contact pad of the other of the substrate (22) and the semiconductor device, said male

² The partially filling limitations do not further distinguish the prior art from the claimed invention, because the structural features imparted is simply a member that has an aperture with a bottom. Furthermore, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

member having: a jacket having an end (e.g. surface of 37) configured complementarily to said upper portion of said aperture of said jacket of said female member (32; Fig. 9), said jacket having an aperture configured to be located over the corresponding contact pad; and a conductive center substantially filling said aperture (see footnote 1);

(cl. 2, 52) wherein said aperture of said jacket of said female member (42) is configured to partially limit insertion of said male member thereinto (e.g. bottom & sides of 42 limit; see e.g. Fig. 9);

(cl. 4, 13, 33, 39, 51, 55) the aperture tapers inwardly³ (aperture portion of 39; Fig. 8, 9);

(cl. 5) an outer surface of jacket (37) of said male member is configured to partially limit insertion of said male member into said aperture of said jacket of said female member (Fig. 9);

(cl. 6, 7, 34, 36, 56) wherein said outer surface is tapered (e.g. portion of 37 next to 34) and like a cone so therefore frustoconical;

(cl. 8, 31, 49, 53) wherein said jacket of said male member has an end (e.g. tip of 37 closest to 29) portion with a smaller periphery than a base portion of said jacket (e.g. wide portion of 37; See Fig. 1, top-down view)

(cl 12) said aperture of said jacket of said female member is configured to facilitate alignment of said male member and said female member (Fig. 1);

³ Note, although shown in the prior art, even if the feature were not shown, they still would be considered obvious in light of any standard chip socket (e.g. Kardon, U.S. 5,418,471) since applicant has not disclosed that his claimed shapes are unobvious or otherwise critical. See M.P.E.P 2144.04[R-1]

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(cl. 14) wherein an outer surface of said jacket of said male member is configured to facilitate alignment of said male member and said female member (e.g. shape of hole aligned also with shape of jacket (Fig. 1);

(cl. 15) wherein said outer surface tapers outward-from said-end (e.g. tip of 37) to a base portion (e.g. widest portion of 37) thereof;

(cl 16) and the outer surface (37) is cone shape and therefore frustoconical;

(cl. 21, 44) wherein at least one of said conductive centers comprises a solder, a metal, or a metal (Col. 2-3, Lines 66-1);

(cl. 37) wherein an upper portion (e.g. outermost portion of 39) of said aperture has a larger periphery than a base portion of said aperture (e.g. where 29 meets 34);

(cl. 69) wherein the semiconductor is a semiconductor (Col. 3, Lines 19-20).

8. Subrahmanyam does not disclose its male and female connector comprised of multiple pieces or the claimed materials⁴ for it female member,

9. However, applicant has not disclosed that his breaking a known structure into multiple pieces produces unexpected results or otherwise critical. As such, the forming the individual elements such as jacket and conductive center from an integral component would have been obvious to one of ordinary skill in the art, since it has been held that making integral items separable or visa-versa is prima facie obviousness. Cf., In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the

⁴ Examiner recommends that applicant clearly claim that the material is separate and distinct/different from the remaining portion of the female body. Thereby, bringing to light that the jacket and center conductive portion of either the male or female portions are different. This would distinguish applicant's invention over cited prior art.

prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice."), See M.P.E.P. §2144.04.

10. With respect to the selection of the claimed material, the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See M.P.E.P. §2144.07.

11. Claim 25 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subrahmanyam et al. (U.S. 5,411,400) in combination with Abe et al. (U.S. 5,646,442).

12. Subrahmanyam discloses the same invention as claimed in paragraphs 7-10 of this office action except that his chip package is cylindrical instead of a BGA, Abe (Fig. 2A, 4) shows that for a socket connection terminals that cylindrical terminals are equivalent to BGA structure known in the art. Therefore, because these two contact structures are art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute Ball type terminals for cylindrical ones.

Response to Arguments

13. Applicant's arguments filed April 1, 2007 have been fully considered but they are not persuasive. Applicant contends that his various examples in the specification apprise one of ordinary skill in the art of the metes and bound of jacket citing to MPEP

2173.01. However, while applicant may have disclosed various embodiments, no such special definition has been given such that the term has been clearly set forth. Embodiments do not create special definitions, and because of the various embodiments, the term "jacket" becomes even more unclear.

Applicant further contends that the prior art does not show a jacket because all it allegedly shows is inserts and heads and that nowhere does it explicitly for inherently disclose a female member partially filled. As indicated, applicant claim is a product by process limitation. Although several inquiries have been made as to what is the structural difference between a female member partially filled and a solid female member, applicant has not clarified. As such, they are interpreted as resulting in the same structure, a center mass with a ring along the top portion of the mass. Irrespective if applicant or prior art refers to its structures as bases, inserts, pedestals. Etc, provides the same structure as claimed.

As for applicant's other contentions, he has failed to address the examiner's remarks in the office action how each limitation is met. For example, applicant further contends that the prior art does not have a male member with a jacket having a top portion smaller than base portion of jacket. The office action explicitly points to the slanted outward shape insert of the prior art having a top portion smaller than the lower outward slanted edges. Assuming that a jacket is merely a female member with an aperture, once an insert or male member fills and is placed in the aperture, there is no difference structurally than if the features were integral. Moreover, making separate pieces integral and vise-versa are merely obvious variations as indicated in the office

action. Because applicant has not addressed these types of remarks, his general arguments that the prior art does not have it does not overcome examiner's prima facie case of obviousness. See M.P.E.P 2145 [R-3]

Conclusion


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Mitchell whose telephone number is (571) 272-1931. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on (571) 272-1702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ex. Mitchell, J.D.




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